

REMARKS

This amendment is in response to the Official Action mailed June 10, 2003. Claims 1-15, 17-36, 38-56 and 58-114 remain pending in this application. Claims 16, 37 and 57 have been canceled. Claims 1, 17, 18, 22, 38, 39, 43, 58, 59, 63, 69, 81, 88 and 100 have been amended.

The Examiner rejected claims 1, 2, 4-9, 11, 15-23, 25-30, 32, 36-43, 45-50, 52, 56-65, 67-72, 74, 78-84, 86-91, 93, 97-102, 104-106, 108 and 112-114 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,075,455 ("*DiMaria*") in view of U.S. Patent No. 6,111,977 ("*Scott*"). Among these claims, claims 1, 22, 43, 63, 81 and 100 are independent.

With respect to claims 1, 2, 22, 25, 43, 45, 63, 65, 67, 86 and 100, the Examiner states that "*DiMaria* teaches a biometric time and attendance system... comprising a host 20, which includes a processor and a memory..., a data input device 10, and an internal clock keeping track of occurrence of access..., a data interface device such as a keypad and [a] display device." (Official Action at 3.) The Examiner further states that the system disclosed in *DiMaria* "keeps track of [an] individual's entry/exit into a particular location and time if desired." (*Id.*) The Examiner admits, however, that "*DiMaria* fails to specifically teach or fairly suggest that the device is a portable unit." (*Id.*)

With respect to portability, the Examiner states that "*Scott* teaches a portable fingerprint recognition transmitter used in time and attendance... and [that *Scott*] further discloses wireless transmitter/receiver 26 interfacing with [a] host machine... and a rechargeable battery 42 as a power source for the device." (*Id.*) According to the Examiner, therefore, "[i]n view of *Scott*'s teaching, it would have been obvious to an [individual having] ordinary skill in the art at the time the

invention was made to further incorporate a portable unit with the same functionality to the teachings of *DiMaria* in order to provide mobility to the employees, and greater flexibility in defining controlled areas." (*Id.*)

It is axiomatic, however, that a *prima facie* case of obviousness requires that "the prior art reference (or references when combined) must teach or suggest all the claimed limitations." *Manual of Patent Examining Procedure*, § 2143 at 2100-125 (8th ed., August 2001, rev. 1, February 2003) (hereinafter *MPEP*).¹ The combination of *DiMaria* and *Scott* does not teach or suggest all of the limitations of Applicants' independent claims, namely, claims 1, 22, 43, 63, 81 and 100.

DiMaria discloses a "multiple terminal biometric time and attendance system" comprising a plurality of terminals 10 connected to a host 20. (Column 3, lines 6-7; Figure 1.) Each terminal comprises a display 14, a keypad 16 and an "epidermal typographical scanner" for recording, for example, fingerprint data. (Figure 2.) The host comprises a processor 30, a RAM 40 and a ROM 50 and is connected to an input unit 70, an output unit 80 and a database 60. (Figure 1.) The database stores "epidermal typographical patterns and access information." (Column 3, lines 26-27.) "Each terminal 10 is placed at a location where access control is desired." (Column 3, lines 28-29.) As explained in *DiMaria*, if "the transmitted epidermal typographical pattern of an individual wishing to gain access [to a location] does not match one of the stored epidermal typographical patterns, access is denied..., [and] the host computer stores [the] time of the attempt and generates a report." (Column 3, lines 55-59.) On the other hand, if access to the location is permitted, "the host 20 may store the date

¹All references to the *Manual of Patent Examining Procedure* (*MPEP*) are to the 8th ed., August 2001, revision 1, February 2003.

and time an individual gains admission to or exit from a controlled area." (Column 4, lines 20-21.)

Scott discloses a "portable fingerprint recognition transmitter that is compact, being less than the size of a cigarette pack, allowing the fingerprint recognition transmitter to be carried by an individual in a pocket or purse." (Abstract.) "The fingerprint recognition transmitter operates to take the image of the fingerprint and formulates a fingerprint image capable of transmitting through infrared or radio frequency to a receiver having previously stored fingerprint images so as to cause a comparison between the image taken and the image stored for purposes of unlocking a security area." (*Id.*)

Applicants' independent claim 1 recites that the "time and attendance recording apparatus" is "self-contained" and "personally portable." The claim further recites that the apparatus comprises "a processor," "a data storage device," "a data input device," "a clock," "a geographical locating device," "a data interface device," "a power source" and "a casing." With respect to the "clock," the claim recites that it is "adapted for providing the time and date of said entering [of attendance data by a person indicating the identity of said person and that said person is clocking into or out of a worksite] to said processor." With respect to the "casing," the claim recites that it is "for housing said processor, said data storage device, said clock, said geographical locating device, said data interface device and said power source to provide personal portability for said time and attendance recording apparatus." Applicants' other rejected independent claims contain similar recitations.

The combination of *Scott* and *DiMaria* does not result in a "self-contained, personally portable time and attendance

recording apparatus" as recited in these independent claims. Terminals 10 of *DiMaria* cannot operate independently of host 20. Each terminal comprises only a display 14, a keypad 16 and an epidermal typographical scanner 12. The collected epidermal information is transmitted to the host for processing. In particular, terminals 10 do not include a processor, a data storage device, a geographical locating device [or a biometric-capture device], a power source or a clock "adapted for providing the time and date of said entering [of attendance data by a person indicating the identity of said person and that said person is clocking into or out of the worksite] to said processor." The determination and processing of timing data is performed by host 20. (Column 3, lines 58-59; column 4, lines 20-23.)

The deficiencies of *DiMaria* are not overcome by *Scott*. Like the terminals disclosed in *DiMaria*, the fingerprint recognition transmitter disclosed in *Scott* cannot operate independently of the receiver. Although the fingerprint recognition transmitter is portable, this device, like the terminals disclosed in *DiMaria*, merely transmits the fingerprint information to the receiver for identification and further processing. Also, like *DiMaria*, *Scott* also does not disclose a geographical locating device or a clock "adapted for providing the time and date of said entering [of attendance data by a person indicating the identity of said person and that said person is clocking into or out of the worksite] to said processor." Combining *Scott* with *DiMaria*, therefore, merely results in the host-dependent ("dumb") terminals disclosed in *DiMaria* being made portable. This combination does not "teach or suggest all the claimed limitations" of Applicants' independent claims 1, 22, 43, 63, 81 and 100. *MPEP*, § 2143 at 2100-125.

With respect to the dependent claims, the Examiner states, with respect to dependent claim 4, that "since each terminal 10 is located at a location where access control is desired..., each location can be identified and activities at each location can be tracked and accounted for." (Official Action at 4.) However, claim 4 states that "said data storage device is adapted for storing indicia identifying said worksite and a company employing said person, said processor is adapted for associating said indicia with said related data and said data interface device is adapted for transmitting said indicia and said related data through said communication network to said computer." *DiMaria* does not even disclose a processor or a data storage device in terminals 10, let alone the other limitations of this claim. The only processor and data storage device disclosed in *DiMaria* are in host 20.

With respect to dependent claims 20, 21 and 41, the Examiner contends that although *DiMaria* "does not provide a detailed structure of the terminal 10, it is inherent that the terminal is equipped with memory to store transactional data received from the host and a process[or] [for] controlling other interfaces installed therein such as a scanner, display and keypad." (*Id.*; emphasis added.) This contention is incorrect.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

MPEP, § 2112 at 2100-52, emphasis added; quoting *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q. 2d 1949, 1950-51 (Fed. Cir. 1999).

A memory and a processor are not "necessarily present" in terminals 10 of *DiMaria*. These terminals are connected, apparently by wires, to host 20, and host 20 includes processor 30, random access memory (RAM) 40 and read only memory (ROM) 50. Also, host 20 is connected to database 60. Processor 30 of host 20, therefore, can control the "interfaces installed... [in terminals 10] such as... [the] scanner, display and keypad." Also, data to be transmitted to terminals 10 and displayed on display 14 of these terminals can be stored in RAM 40, ROM 50 or database 60 of host 20. Since such a scheme requires less hardware, it is at least as likely as the "inherent" structure proposed by the Examiner.

With respect to claims 23, 64 and 83, the Examiner contends that since the system disclosed in *DiMaria* "generates activity reports by locations..., location information where the terminals are installed is provided to the processor." (Official Action at 4.) The Examiner further states that "[a]lthough physical coordinate of location may not be directly provided by the terminal 10, it is inherent that the system keeps track of locations (physical or otherwise) where the terminals are installed for accountability/activity reports." (*Id.*; emphasis added.) Claims 23, 64 and 83 recite, however, either directly or as a result of their dependency, that the self-contained time and attendance recording apparatus further comprises "a geographical locating device connected to said processor, said geographical locating device being adapted for providing the geographical location of said apparatus to said processor." Although it may be "inherent that the system disclosed in *DiMaria* keeps track of locations... where the

terminals are installed," any such inherent disclosure does not mean that a "geographical locating device" "is necessarily present" in terminals 10. On the contrary, since the system disclosed in *DiMaria* is intended to be permanently installed, typically in a building, database 60, RAM 40 or ROM 50 of host 20, in all likelihood, stores the locations of terminals 10, and any change in these locations requires reprogramming of the information stored in one or more of these memories to identify the terminals' new locations.

With respect to claims 78, 79, 81, 82, 84, 97, 98, 101, 102, 112 and 113, the Examiner contends that, as shown in Figure 1 of *DiMaria*, "the plurality of terminals are connected to the host via [a] network..., and a remote database 60 is also connected to [a] network for providing biometrical information... The remote database is connected via [a] telecommunication network, which can be part of [the] Internet network." (Official Action at 5.) *DiMaria*, however, provides absolutely no disclosure that the wires connecting terminals 10 and host 20 are a "telecommunication network" and, in particular, the "Internet network." Also, even if the Examiner's hypothesis were correct, such a disclosure would not result in the subject matter of claims 78, 79, 81, 82, 84, 97, 98, 101, 102, 112 and 113. For example, claim 78 recites "storing said messages in said database [of the first computer] associated with said identity [of the person using the time and attendance recording apparatus], transmitting said messages from said database through said communication network for storage in said data storage device and retrieving said messages from said data storage device for said displaying." Claims 97 and 112 contain similar recitations. *DiMaria* provides no disclosure of storing messages in database 60 of host 20 associated with a particular person using terminals 10. Also, as discussed above,

DiMaria provides no disclosure of a data storage device in terminals 10.

Claim 79 recites that "said communication network comprises the Internet, said first computer is associated with an application service provider on said Internet and said second computer is associated with a company employing said person." Claims 98 and 113 contain similar recitations. *DiMaria* does not even disclose a second computer or a network comprising the Internet, let alone the other elements of these claims.

Claim 81 is an independent method claim that parallels independent system claim 22. For the reasons discussed above with respect to claim 22, *DiMaria*, whether considered individually or in combination with *Scott*, also does not disclose or suggest the elements of claim 81.

Claim 82, which depends upon claim 81, recites "obtaining access to said first computer from a second computer on said network and verifying said related data, including said biometric characteristic, from said second computer." Claim 101 contains a similar recitation. Claim 84, which depends upon claim 82, recites that "said first computer contains a database storing a reference for said biometric characteristic and said verifying comprises comparing from said second computer said biometric characteristic with said reference." Claim 102 contains a similar recitation. As indicated above, *DiMaria* does not even disclose a second computer, let alone the other elements of these claims. The only computer disclosed in *DiMaria* is processor 30 of host 20.

With respect to claims 80, 99 and 114, the Examiner states that the "employee's picture... is also contained in the entry-card, allowing security persons to perform visual comparison." (Official Action at 5.) Claim 80 recites, however, that "said comparing comprises displaying on a display associated with said

second computer said visual image next to said photograph to enable an operator of said second computer to perform a visual comparison of said visual image and said photograph." Claims 99 and 114 contain similar recitations. The disclosure in *DiMaria* of a personal identification card for insertion in terminals 10 that also contains a photograph of a user does not disclose the subject matter of these claims. As indicated above, *DiMaria* does not even disclose a second computer, let alone the other elements of these claims.

The Examiner rejected claims 3, 10, 24, 31, 44, 51, 66, 73, 85, 92, 103 and 107 under 35 U.S.C. § 103(a) as being unpatentable over *DiMaria* as modified by *Scott*, as applied to independent claims 1, 22, 43, 63, 81 and 100, and further in view of U.S. Patent No. 6,193,153 ("*Lambert*"). The deficiencies in the combination of *DiMaria* and *Scott*, with respect to independent claims 1, 22, 43, 63, 81 and 100, are discussed above. These deficiencies are not overcome by *Lambert*. Since claims 3, 10, 24, 31, 44, 51, 66, 73, 85, 92, 103 and 107 are dependent upon one of claims 1, 22, 43, 63, 81 and 100, dependent claims 10, 24, 31, 44, 51, 66, 73, 85, 92, 103 and 107 are patentable over the combination of *DiMaria*, *Scott* and *Lambert*.

Lambert discloses a "user input device" that simultaneously captures biometric data of a user upon operation of the input device. (Column 4, line 44.) In the embodiment described in *Lambert*, the user input device is a computer mouse, and the biometric data is fingerprint data captured by "a CCD array, or other optical sensor" installed in the mouse. (Column 7, line 56.) *Lambert* suggests that the user input device also may be "a trackball, a keyboard, a keypad, a joystick, a digitizing tablet, a wireless controller, a microphone, a camera or other input devices" and that the action of a user may include "facing

a camera." (Column 4, lines 44-47; Column 9, line 34.) *Lambert* also states:

Other combinations... can be performed. For example, in an employee time card application, an employee may be asked to type-in her employee identification number onto a transparent keypad. In such an example, the identification number would be the event data, and the fingerprint of the employee is the biometric data. When there is a record match of both the employee number and the employee ID number, the punch-in or punch-out time is noted. However when there is either an employee ID/fingerprint mismatch, no fingerprint match, or no employee ID match, the employee may be re-prompted to enter her employee ID.

(Column 13, line 62 - Column 14, line 6.)

Claim 3 recites that "said biometric-capture device comprises a digital camera and said biometric characteristic is a visual image of said person." Claim 3, however, depends upon claim 2, and claim 2 depends upon claim 1. The combination of *Scott*, *DiMaria* and *Lambert* does not result in a "self-contained, personally portable time and attendance recording apparatus" as recited in claims 1, 2 and 3. Except for suggesting the use of a digital camera as a biometric-capture device, *Lambert* adds nothing to the combination of *DiMaria* and *Scott*.

For example, the combination of *DiMaria*, *Scott* and *Lambert* does not teach or suggest, in either the terminals 10 of *DiMaria*, the fingerprint recognition transmitter 10 of *Scott* or the user input device 130 of *Lambert*, a "self-contained, personally portable time and attendance recording apparatus" including "a processor," "a data storage device," "a data input device," "a clock," "a geographical locating device," "a data interface device" and "a power source," as recited in claims 1 and 2. With respect to the "geographical locating device," claim 1 recites that this device is "adapted for providing the

geographical location of said apparatus to said processor, said processor being adapted to store said attendance data and said time and date [captured by the clock] in said storage device and to associate said attendance data and said time and date with each other and with said geographical location as related data." The combination of *DiMaria*, *Scott* and *Lambert* does not even disclose a geographical locating device in terminals 10, transmitter 10 or user input device 130, let alone the generation of "related data" in accordance with this recitation.

Claim 2 recites that the time and attendance recording apparatus of claim 1 further includes a "biometric-capture device" and that the biometric-capture device is "adapted for capturing a biometric characteristic of said person, said processor being further adapted for associating said biometric characteristic with said related data and said data interface device being further adapted for transmitting said biometric characteristic with said related data through said communication network to said computer." The combination of *DiMaria*, *Scott* and *Lambert* does not teach or suggest a processor having a functionality in accordance with this recitation in terminals 10, transmitter 10 or user input device 130.

Claims 24, 44, 66, 85 and 103 are similar to claim 3, and, therefore, Applicants' argument with respect to the combination of *DiMaria*, *Scott* and *Lambert*, as applied to claim 3, also applies to these other dependent claims.

By similar reasoning, Applicants' argument with respect to the combination of *DiMaria*, *Scott* and *Lambert*, as applied to claim 3, also applies to dependent claims 10, 31, 51, 73, 92 and 107. Also, with respect to these dependent claims, the Examiner contends that "*Lambert* further discloses a touch-sensitive keypad used in the embodiment... as recited in claims 10, 31, 51, 73, 92, and 107." (Official Action at 6.) Claims 10, 31,

51, 73, 92 and 107 recite, however, that "said data input device comprises a touch-sensitive screen incorporated into said LCD." The disclosure of a touch-sensitive keypad is not the disclosure of a "touch-sensitive screen incorporated into said LCD."

The Examiner rejected claims 12, 13, 14, 33, 34, 35, 53, 54, 55, 75, 76, 77, 94, 95, 96, 109, 110 and 111 under 35 U.S.C. § 103(a) as being unpatentable over *DiMaria* as modified by *Scott*, as applied to independent claims 1, 22, 43, 63, 81 and 100, and further in view of U.S. Patent No. 6,421,590 ("*Thibault*"). The deficiencies in the combination of *DiMaria* and *Scott*, with respect to independent claims 1, 22, 43, 63, 81 and 100, are discussed above. These deficiencies are not overcome by *Thibault*. Since claims 12, 13, 14, 33, 34, 35, 53, 54, 55, 75, 76, 77, 94, 95, 96, 109, 110 and 111 depend upon one of claims 1, 22, 43, 63, 81 and 100, dependent claims 12, 13, 14, 33, 34, 35, 53, 54, 55, 75, 76, 77, 94, 95, 96, 109, 110 and 111 are patentable over the combination of *DiMaria*, *Scott* and *Thibault*.

Thibault discloses a "tractor-trailer vehicle having a mobile communication terminal [MCT] in communication with a central station using a satellite-based communication system." (Column 3, lines 57-60.) *Thibault* states that other types of communication systems also may be used, "such as cellular telephone systems," and that the system also may be applicable to other vehicles "such as commercial trucks, buses, passenger vehicles, railcars, marine vessels, or airplanes." (Column 3, lines 62; Column 4, lines 1-3.) The mobile communication terminal receives status information required to be entered by drivers of commercial vehicles by the Department of Transportation ("DOT") and the Federal Highway Administration ("FHWA"). This information includes "the time at which they [the drivers] begin driving, the time at which they stop

driving, the time they begin rest, the time that rest terminates, etc." (Column 5, lines 16-18.)

As shown in Figures 1 and 3 of *Thibault*, MCT 106 includes storage device 302, processor 306, time indicator 304 and other elements. Processor 306 is connected to position detector 312, odometer 314 and speedometer 316 of vehicle 102. MCT 106, therefore, is permanently installed on vehicle 102. A similar embodiment in which processor 406 is connected to position detector 412, odometer 414 and speedometer 416 of the vehicle is shown in Figure 4. *Thibault* states that position detector 412 "may be any device well-known in the art for determining the location of a vehicle, such as a device based on the well-known Global Position System (GPS)." (Column 10, lines 43-46.)

Claim 12 recites that "said data interface device comprises a wireless modem," claim 13 recites that "said geographical locating device comprises a global positioning system (GPS) receiver," and claim 14 recites that "said geographical locating device comprises a cellular transmitter/receiver." Claims 33-35, 53-55, 75-77, 94-96 and 109-111 contain similar recitations. The Examiner contends that *Thibault* discloses the subject matter of these dependent claims. *Thibault*, however, does not overcome the deficiencies in the combination of *DiMaria* and *Scott* with respect to independent claims 1, 22, 43, 63, 81 and 100.

For example, Claim 1 recites that the "time and attendance recording apparatus" is "self-contained" and "personally portable." Claims 22, 43, 63, 81 and 100 contain similar recitations. The device disclosed in *Thibault* is permanently installed on a tractor-trailer or similar commercial vehicle. Such a device is far from "self-contained" and "personally portable." In addition, claim 1 recites that the recording apparatus includes "a casing for housing said processor, said data storage device, said clock, said geographical locating

device, said data interface device and said power source to provide personal portability for said time and attendance recording apparatus." No such casing is disclosed in *Thibault*. On the contrary, if the *Thibault* system were housed in such a casing and made personally portable, it would render the *Thibault* system unsatisfactory for its intended purpose. A driver of the vehicle could fraudulently enter the information required by the DOT and the FHWA from a location different from that at which the vehicle is located. "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *MPEP*, § 2143.01 at 2100-127, quoting *In re Gordon*, 733 F. 2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Independent claims 1, 22, 43, 63, 81 and 100, therefore, are patentable over the combination of *DiMaria*, *Scott* and *Thibault*. Since claims 12, 13, 14, 33, 34, 35, 53, 54, 55, 75, 76, 77, 94, 95, 96, 109, 110 and 111 depend upon one of claims 1, 22, 43, 63, 81 and 100, these dependent claims also are patentable over this combination.

In view of the foregoing, Applicants respectfully request that the rejection of claims 1-15, 17-36, 38-56 and 58-114 over *DiMaria*, *Lambert*, *Scott* and *Thibault*, whether considered individually or in combination, be withdrawn.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If for any reason the Examiner does not believe that such action can be taken at this time, however, Applicants respectfully request that the Examiner telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections that the Examiner might have.

Application No.: 10/075,878

Docket No.: TIMEVI 3.0-001

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 
Arnold B. Dompieri

Registration No.: 29,736
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicants

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